

## **Remarks**

### **I. Introduction**

This is in response to the Final Office Action dated November 6, 2008. The Office Action rejected claims 1-2, 7, 9-10, 14, 16-18, and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0087645 to Ertugrul ("Ertugrul") in view of Lehman (Wayback machine: <http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html>) ("Lehman"). The Office Action rejected claims 3-5, 11-12, and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Ertugrul and Lehman in view of U.S. Patent Application Publication No. 2003/0088623 to Kusuda ("Kusuda"). The Office Action rejected claims 6, 13, and 21 under 35 U.S.C. §103(a) as being unpatentable over Ertugrul, Lehman, and Kusuda in view of U.S. Patent Application Publication No. 2003/0105815 to Gusler et al. ("Gusler"). The Office Action rejected claims 8, 15, and 23 under 35 U.S.C. §103(a) as being unpatentable over Ertugrul and Lehman in view of Gusler.

In response, Applicants have amended claims 1, 9, 16, and 17. Claims 1-23 remain for consideration. In response to the finality of the Office Action, Applicants submit a Request for Continued Examination herewith.

### **II. Rejections under 35 U.S.C. §103**

Independent claim 1 was rejected as being unpatentable over Ertugrul in view of Lehman.

In order to "establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. Neither of the cited references, either alone or in combination, teach all of the claim limitations of currently amended independent claim 1. Therefore, Applicants request the withdrawal of the rejections under 35 U.S.C. §103(a).

The subject area of the present invention relates generally to digital communications and, more particularly, to instant messaging (IM). One embodiment of the present invention includes an email compose window as shown in Figure 4B and described on page 17, lines 6-18 of the Specification. The email compose window is supported by email user interface 210 which is in communication with tray manager 102 which, in turn, is in communication with IM user agent 104, address book object 108, and email user agent 106. This intercommunication supports the display of the IM presence of contacts associated with email addresses displayed in email windows as shown in Figure 10 and described on page 19, lines 3 through page 20, line 14. This IM and email integration allows a user to launch an IM chat session with an email contact directly from an email window such as email compose window 408. These aspects are claimed in currently amended independent claim 1 which includes the limitation

providing an **email compose window** for composing an email message, the email compose window configured to designate at least one email recipient, the email compose window including an email send option for sending the email message to the email recipient, **the email compose window including an IM launch option for launching an IM chat session with the at least one recipient of the email message**, the email compose window being configured for a user to input a message in the email compose window and the IM option being configured to facilitate automatically launching an IM session in response to selection of the launch IM option.

Ertugrul and Lehman, separately or in combination, do not disclose the limitations of currently amended independent claim 1.

The Office Action indicates that “Ertugrul teaches an email compose interface having IM capabilities in such that being configured for a user to input a message in an email compose interface and the IM option being configured to facilitate automatically launching an IM session in response to selection of the launch IM option provided to the user for interaction with.” Applicants disagree, however, in order to expedite prosecution, Applicants have amended independent claim 1 to recite “providing an

email compose **window...the email compose window including an IM launch option** for launching an IM chat session with the at least one recipient of the email message.” Ertugrul does not disclose this limitation. Ertugrul paragraph [0034] states that “FIG. 2 illustrates the body of a representative email message 200 received by an email recipient in accordance with the current improvement. Embedded in message 200 is an ‘instant messaging’ window 202.” However, this is an email read window and not an email write window. Although Ertugrul FIG. 2 implies that a compose window may be opened by clicking on the ‘Reply’, ‘Reply to All’, or ‘Forward’ buttons, Ertugrul does not describe what is contained in the compose window opened after one of the buttons is clicked. Thus, Ertugrul does not disclose “providing an email compose window...the email compose window including an IM launch option for launching an IM chat session with the at least one recipient of the email message” as recited in currently amended independent claim 1. Lehman fails to disclose the limitation missing from Ertugrul.

Lehman is directed to instructing users how to use various instant messaging programs. The only reference to ‘email’ in Lehman is in connection with a description of how a user can update his or her member profile. Thus, Lehman does not disclose “providing an email compose window...the email compose window including an IM launch option for launching an IM chat session with the at least one recipient of the email message” as recited in currently amended independent claim 1.

Thus, for reasons discussed above, Ertugrul and Lehman, separately or in combination, do not disclose each and every limitation of currently amended independent claim 1. As such, the cited references cannot render independent claim 1 unpatentable under 35 U.S.C. §103(a). Independent claims 9, 16, and 17 have been amended similarly to independent claim 1 and therefore cannot be rendered unpatentable over the cited references for the same reasons discussed above in connection with independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejections of independent claims 1, 9, 16, and 17 as being unpatentable over Ertugrul and Lehman under 35 U.S.C. §103(a).

For the reasons discussed above, all independent claims are allowable over the cited art. Allowance of all independent claims is requested.

All remaining dependent claims are dependent upon an allowable independent claim and are therefore also allowable. In addition, as discussed immediately below, claims 8, 15, and 23 contain further limitations that render them separately patentable over other art cited in the Office Action against these claims.

Dependent claims 8, 15, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ertugrul and Lehman in view of Gusler. Claims 8, 15, and 23 add the limitation of “wherein saving the IM transcript comprises: saving the IM chat transcript as an email message.” As described on page 46, lines 5-6, “[b]y saving the IM chat transcript as an email message, the thread history may be directly exported to email programs such as Microsoft Outlook.” The Office Action admits that this limitation is not disclosed by Ertugrul and Lehman and indicates that the limitation is disclosed by Gusler paragraph [0041] and states that “IM messages are saved in a log and the log can be placed in an e-mail to be sent out.” Although Gusler paragraph [0041] indicates that transcripts can be sent either as an attachment to an email or as an email, Gusler paragraph [0041] does not disclose saving IM chat transcripts as an email message. Thus Gusler does not disclose “wherein saving the IM transcript comprises: saving the IM chat transcript as an email message” as recited in claims 8, 15, and 23 which, as mentioned in the Specification, provides the significant advantage of facilitating export of the transcript. As such, Ertugrul, Lehman, and Gusler, separately or in combination, do not disclose each and every limitation of dependent claims 8, 15, and 23. Accordingly, Applicants respectfully request withdrawal of the rejections of claims 8, 15, and 23 under 35 U.S.C. 103(a).

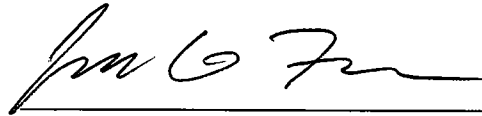
### III. No New Matter has Been Added

The amendments to claims 1, 9, 16, and 17 do not add new matter. Support for these amendments can be found at least in Figures 1-5, 10, and 18 and in the Specification on page 17, lines 6-18, page 41, line 19 through page 42, line 7.

IV. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J G Fenske", written over a horizontal line.

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